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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/007,788

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Michael J. Bonnette

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1848

24113

7590

12/12/2003

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EXAMINER

ROBERTS, PAUL A

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 12/12/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/007,788

Applicant(s)

BONNETTE ET AL.

Examiner

Paul A Roberts

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 3,5-7 and 10-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/6/01 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). attached.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 3, 5, 6, 10, 11, 12, 13, 14, 16 17, 18, 20, and 21 do not read on the elected figure 5.
2. Regarding claims 3 and 18, the applicant has elected figure 5. The disclosure does not enable one of ordinary skill in the art to build a device having 1<sup>st</sup> and 2<sup>nd</sup> aperture because the specification does not mention any apertures in the embodiment of figure 5 nor does figure 5 show 2 apertures. Further, no handheld structure is supported by the specification for figure 5. There is no label in the specification for a handheld device in figure 5. Specifically for claim 3, there does not appear to be a passageway 70 in figure 5. Also, as required by claim 18, there are no conduits shown or disclosed in the specification for figure 5. Claims 20 and 22 do not read on figure 5 because claim 18 does not read on figure 5.
3. Regarding claims 5 and 6, the depressible roller mechanism is not disclosed for figure 5. Further, figure 5 does not appear to have a first roller, or a second roller. There is no disclosure of a threshold force as it relates to figure 5.
4. Regarding claim 10, figure 5 does not disclose a removable sealing assembly. The specification does not disclose the sealing assembly can be removed. In fact, the figure shows the sealing assembly to be unitary in construction. Claims 11-14, and 16-17 do not read on the figure because they are dependent on claim 10.
5. Claims 1, 2, 4, 8, and 9 are currently pending. Claims 3, 5, 6, 10, 11, 12, 13, 14, 16 17, 18, 20, and 21 are withdrawn by the examiner as not reading on the elected invention. Claims 7, 15, 19 and 22-33 were withdrawn by the applicant as not reading on the elected invention.

*Drawings*

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the hand-held apparatus must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. From the disclosure, it appears the handheld apparatus is just a label for the combined structure of elements 60 and 80. Nonetheless, the apparatus needs a label on the drawings and that label needs to be recited in the specification.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation "handheld apparatus" in line 1. There is insufficient antecedent basis for this limitation in the claim. The specification must support the disclosure of a handheld apparatus for figure 5. Currently, it is not clear what is meant by a handheld apparatus in figure 5, because there is no reference to figure 5 in the specification, and the

passage concerning figure 5 does not disclose that figure 5 contains a handheld apparatus. Also, the specification does not support that the inflation/deflation apparatus is a handheld apparatus.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Valley et al. (Valley) US 6251093. Valley discloses a gas inflation/evacuation system removably connectable to a proximal portion of a guidewire assembly, comprising: means for evacuating air from the guidewire assembly (col. 16, 5-15); and means for introducing a biocompatible gas (col. 13, 45-50) into the guidewire assembly (897, figure 34) to inflate an occlusive balloon proximate a distal end of the guidewire assembly a plurality of times; and means (col. 38, line 12-19) for selectively sealing the proximal portion of the guidewire assembly at one of a plurality of separate locations to form one of a plurality of airtight seals of the guidewire assembly.
9. Regarding claim 2, the system has a pump that adds/removes air. A pump is handheld.
10. Regarding claim 4, the system contains a means for sealing that comprises a crimping mechanism.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valley '093. Valley does not go into detail about how to package the surgical instrument of claim 1. It is common practice to package a surgical device in sterile packaging within a vessel containing biocompatible gas. One would place the device in sterile packaging to prevent possible contamination of the device leading to patient infections. Additionally, one would package the device in a field containing biocompatible gas because using a non-biocompatible gas would likely cause the patient to adversely react to the treatment. At the time of the invention it would have been obvious to one having ordinary skill in the art to package the device with sterile packaging and to package the device in a vessel or field containing biocompatible gas because both practices are well-known in the art, and not following those practices would inevitably lead to adverse patient post-surgical reactions.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tube clamps US 3,773,290, 5514109, and 6,234,448 have similar structure to the clamp of figure 5.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul A Roberts whose telephone number is (703) 305-7558. The examiner can normally be reached on 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J Milano can be reached on 703-308-2496. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Paul Roberts  
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12/04/03



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